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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,753	07/15/2003	Tony Skuse	1-24641	7392
4859	7590	06/17/2004	EXAMINER	
MACMILLAN SOBANSKI & TODD, LLC ONE MARITIME PLAZA FOURTH FLOOR 720 WATER STREET TOLEDO, OH 43604-1619			NGUYEN, CHI Q	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n No.</b> 10/619,753	<b>Applicant(s)</b> SKUSE ET AL.	
	<b>Examin r</b> Chi Q Nguyen	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 18-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election***

The applicant elected Specie No. 1 (figures 1-3 to claims 1-17) on 4/23/04 is acknowledged.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show a light transmissive panel 13 and the panel matches the contour and spacing of one or more roof tiles, shingles, slates or roofing sheets as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: in line 6, the applicant is advised to remove "said" and insert "roof" if it is the same of the roof covering cited in line 5. Appropriate correction is required.

Claim 10 is objected to because of the following informalities: is "the duct" cited in claim 10 same as "the light-directing duct" cited in the previous claims. Clarification is required.

Claim 15 is objected to because of the following informalities: the applicant is advised to change "the lower end" to " a lower end". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Witzig (US 5,613,333).

In regard to claim 1, Witzig teaches a skylight assembly comprising a transparent light transmissive panel 3, which has an upper surface and lies in the plane of the roof covering, and a light-directing duct 70, which directs light from the panel into the interior of the building. In regard to claims 6, and 10-12 because the applicant did not positively

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claim a roof structure, therefore any structures related to the roof are not being considered.

In regard to claim 2, the light-directing duct 70 is fitted to an underside of the panel 3. In regard to claims 3, 4, the light directing duct 70 is sealed to an underside of the panel by gasket or inner ring 15, outer ring 60, and urethane seal (col. 5, lines 29-41). In regard to claim 5, the upper surface of the panel 3 is flush with an upper surface of the covering or shingles S (see fig. 6). In regard to claim 7, the panel 3 aligned with the light directing duct 70 and opaque portion or mounting template 5.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witzig (US 5,613,333).

Witzig teaches a skylight assembly comprising a transparent light transmissive panel 3, which has an upper surface, and lies in the plane of the roof covering, and a light-directing duct 70, which directs light from the panel into the interior of the building. The light directing duct 70 is fitted to an underside of the panel 3; the light directing duct 70 is sealed to an underside of the panel by gasket or inner ring 15, outer ring 60, and urethane seal (col. 5, lines 29-41); the upper surface of the panel 3 is flush with an upper surface of the covering or shingles S (see fig. 6), the panel 3 matches the contour

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and spacing of one or more roof shingles R; the panel 3 aligned with the light directing duct 70 and opaque portion or mounting template 5.

In regard to claims 8 and 9, Witzig teaches the structural elements for the skylight as stated except for the opaque portion matches is colored and textured to match the roof covering. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to paint the opaque portion for a matching color to match with the roof covering. The motivation for doing so would have been to enhance the aesthetically pleasing surface.

In regard to claims 13 and 14, Witzig teaches the structural elements for the skylight as stated including the light panel 3 having a first or closed position to allow light into the room and a second or open position to allow ventilation of the room (see col. 3, lines 14-19). Witzig does not teach expressly the panel further comprises an air vent or apertures for allowing air from outside the roof to circulate through the duct. The examiner takes Official Notice the fact that the panel having apertures or the panel having operative open/close would have been performed the similar function such as circulating outside air into the building through the duct.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witzig (US 5,613,333) in view of Borges (US 2003/0000158).

Witzig teaches a skylight assembly comprising a transparent light transmissive panel 3, which has an upper surface which is substantially identical in shape to an upper surface of a roof covering R and which lies in the plane of the roof covering, and a light directing duct 70 which directs light from the panel into the interior of the building; the light

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directing duct 70 is fitted to an underside of the panel 3; the light directing duct 70 is sealed to an underside of the panel by gasket or inner ring 15, outer ring 60, and urethane seal (col. 5, lines 29-41); the upper surface of the panel 3 is flush with an upper surface of the covering or shingles S (see fig. 6); the panel 3 aligned with the light directing duct 70 and opaque portion or mounting template 5.

In regard to claims 15-17, Witzig teaches the structural elements for the skylight as stated except for the lower end of the duct is provided with a transparent or translucent light transmissive cover and made from a plastics material. Borges teaches flexible reflective skylight tubes having a duct 20, a plastic lower end having a clear obscure light panel or cover 18. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Witzig with Borges for the clear plastic light panel or cover. The motivation for doing so would have been to protect dusts infiltrating into the building.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. FR 2637929, Hoy (US 6,604,329), Damron (US 5,561,952), Schulz (US 4,663,905), Bechtold (US 4,750,302), Yannucci (US 5,673,520), Verby (US 5,806,255), Landis (US 2004/0000107) teach skylight structure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (703) 605-1224, Mon-Thu (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be

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reached at (703) 308-0839. The fax number for the organization where this application or proceeding assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

1113.

CQN

CQN

6/7/04

  
Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600